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IN THE

Supreme Court of the United States

OCTOBER TERM, 1970

No. 711

BECKMAN INSTRUMENTS, INC. AND LELAND C. CLARK, JR.,
Petitioners,

v.

CHEMTRONICS, INC. AND J. RYAN NEVILLE,
Respondents.

ON PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

BRIEF FOR RESPONDENTS IN OPPOSITION

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October 22, 1970

FIDELITY PRINTING COMPANY, INC., HOUSTON

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OPINION BELOW

The opinion of the Court of Appeals for the Fifth Circuit (App. 13a)[1] and its denial of Petitioners' motions for rehearing and for rehearing *en banc* (App. 55a) are now officially reported at 428 F.2d 555.

STATUTORY PROVISIONS INVOLVED

35 U.S.C. § 102 (1964) provides:

§ 102. Conditions for patentability; novelty and loss of right to patent

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[1] Such citations are to Petitioners' Appendix and page therein.

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

. . .

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it . . .

35 U.S.C. § 115 (1964) provides:

§ 115. Oath of applicant

The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent . . .

STATEMENT OF THE CASE

Petitioners seek review of the judgment of the Court of Appeals for the Fifth Circuit that U. S. Patent 2,913,386 (the Clark patent) is invalid as anticipated by a prior art invention. Petitioners desire a reversal of that holding of invalidity to extract themselves from the antitrust proscriptions against fraudulently procured patents set forth in *Walker Process Equipment, Inc.* v. *Food Machinery & Chemical Corp.*, 382 U.S. 172 (1965). See Respondents' Petition for Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit, October Term, 1970, No. 705.

A. The Clark Patent and the Prior Act

The Clark patent relates to an electrochemical device for measuring the amount of a gas, such as oxygen, carbon

monoxide or sulfur dioxide, typically in a fluid. Clark's alleged invention was a particular arrangement of old components, that is, placement of two electrodes behind a semipermeable membrane (App. 18a, 22a, 23a, n. 10, 24a) to provide a measuring device. The primary object recited in the Clark patent (App. 23a-24a) confirms this fact.

The Court below noted that prior to Clark's alleged invention, one Dr. Richard Stow "advanced the art of membrane electro-chemistry by . . . plac[ing] *both* electrodes behind a single selectively permeable membrane . . . to measure the concentration of carbon dioxide in blood" (App. 17a-18a). Thus, Stow did earlier precisely what Clark claimed to have invented (App. 19a, 25a). Stow was seeking to measure carbon dioxide,[2] but he made this measurement using the identical arrangement of components as later did Clark (App. 18a, 25a).

The Court of Appeals also pointed out that the art, prior to both Stow and Clark, had recognized the usefulness of "protecting the [measuring] electrode by a membrane selectively permeable to the substance to be measured . . . . [to] prevent both fouling and pollution while allowing the appropriate sample constituent to diffuse through to the measuring electrode" (App. 17a). In fact, Clark's own prior work, in which he used a membrane covered measuring electrode to measure oxygen (App. 18a), had been published and was prior art.

B. The Court of Appeals' Holding of Anticipation

Petitioners sued Respondents in 1965 for infringement of the Clark patent which has been broadly asserted and

[2] In the art of membrane electrochemistry, it was well known at the time which electrode materials could be used to measure oxygen, carbon dioxide, sulfur dioxide, etc. If one wanted to measure carbon dioxide, well-known electrodes sensitive to carbon dioxide, such as glass electrodes, were selected. If one wanted to measure oxygen, well-known electrodes sensitive to oxygen, such as platinum electrodes, were selected.

licensed. As discovery progressed, Respondents uncovered the fact that the Stow prior art, which squarely anticipated the claims of the Clark patent, had been known to Petitioners all the time but had been secreted from the Patent Office.

With their lucrative licensing position at stake, Petitioners attempted to maintain their patent position in spite of this anticipatory art by consistently diverting judicial attention from the Clark *patent* by advocating alleged differences between the Clark *device* and the prior art *device* as the basis for patentability.

On appeal, Petitioners continued to argue those alleged differences while Respondents urged the Court of Appeals to compare the Clark patent and the Clark patent claims with the prior art. The Court of Appeals properly focused on the Clark patent and its prosecution history before the Patent Office.

The Court of Appeals was not lured into an elaborate discussion of the merit or lack of merit in the Clark device, or of Petitioner Clark himself, but rather focused on the patent (App. 20a):

> [W]e are not required to decide whether Dr. Clark created an invention that could have been protected under a proper, lawfully secured patent . . . . We assume for purposes of the following discussion that Clark's cell was patentable in some manner. This assumption granted, there are many ways that a patent on the device could have been written and [Petitioners] in this instance chose to write it broadly and generally. Our attention must focus on the claims the patent actually makes.

Again, the arguments for validity advanced in the Petition are founded on alleged differences between the Clark

device and the prior art device. Moreover, the express refusal of the Court of Appeals to consider these diversionary arguments has been contorted in Question 1 to suggest that the Court of Appeals held Clark to have made a "concededly patentable" invention under the law of *United States v. Adams*, 383 U.S. 39 (1966). No such holding was made below.

In the *Adams* case, *supra*, which Petitioners strain to analogize to their circumstance, this Court satisfied itself that the basis upon which the *Adams* patent distinguished the prior art was manifest in the patent itself and "was not the after-thought of an astute patent trial lawyer." 383 U.S. at 49.

In this case, the hindsight fabrication by Petitioners of the now-alleged differences is graphically highlighted by the fact that these alleged differences were not relied upon by Petitioners in advocating the patentability of Clark's alleged invention before the Patent Office. What Petitioners *did* rely on was an arrangement of components and the advantages of that arrangement — an arrangement fully anticipated by the Stow prior art which had realized the same advantages. The Court of Appeals noted (App. 31a-32a):

> [Petitioners] made affirmative representations in the papers they filed to the effect that there had been no previous invention displaying the properties that the Clark device had in common with the Stow device.[22]
>
> [22] [Court's footnote.] For example, in a paper filed with the Patent Office during the pendency of the application, [Petitioners] represented that "*The Clark instrument is the only one which can measure the partial pressure of a gas in a fluid regardless of the composition of the fluid.*" [Emphasis in original papers filed in the Patent Office.] . . . . The Stow invention also had this capability. There are a number of similarly misleading representations throughout the papers filed by [Petitioners] . . . .

The now-alleged differences are further negated by the scope of the sublicenses under which Petitioners require royalty to be paid based on the Clark patent. The Stow prior art is clearly within the broad definition of royalty-bearing devices in those sublicenses.[3]

The final rebuttal of the alleged differences advocated as grounds for patentability lies, however, in the patent claims themselves. As one example, claim 12 (App. 52a) contains no reference either to the measurement of oxygen, or to the field of polarography, or to the flow of electric current, or to the nature of the electrode. In a word, none of Petitioners' alleged differences (Pet. 7)[4] are to be found.

C. The Issue of Fraud on the Patent Office

Early during prosecution of the Clark application, one Allen Strickler, a Beckman patent engineer whom the Court of Appeals found to be "knowledgeable in patent law" (App. 31a, n. 21), wrote to Beckman management[5] that prior to Clark's alleged invention Beckman had collaborated with Stow on various designs of membrane-covered electrode devices. Strickler specifically noted that Stow's prior device "[was] clearly within the scope of claims [then] in the Clark application" (App. 31a). Although Petitioners now assert that all those claims were cancelled, they were in fact replaced by claims of sufficient scope to clearly include the Stow prior art.

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[3] The sublicenses require 15% royalties on

> "An apparatus for exposure to a medium containing a constituent to be measured including, but not limited to a pair of electrodes separated from said medium by a membrane permeable to said constituent and joined or adapted to be joined by a body of electrolyte."

[4] Such citations are to the Petition and page therein.

[5] The full text of Strickler's "confidential" intracorporate letter is reproduced as an Appendix to this Brief.

Based on these facts, the Court of Appeals found (1) that Petitioners knew of the Stow prior art and its significance to Clark's alleged invention (App. 30a); (2) all the evidence tended to show that the omission of disclosure of Stow to the Patent Office was made deliberately (App. 28a); (3) that the omission was compounded with misleading representations to the Patent Office as to novel aspects of the alleged Clark invention (App. 31a-32a, n. 22); and (4) that Petitioners' sole exculpatory explanation that they considered Stow irrelevant was "utterly incredible" (App. 32a).

In view of these findings, the Court of Appeals found the Clark patent invalid for fraud and remanded for further proceedings on Respondents' antitrust counterclaim founded on *Walker Process Equipment, Inc.* v. *Food Machinery and Chemical Corp.*, 382 U.S. 172 (1965).

ARGUMENT

A. The Judgment of Invalidity Was Reached After a Careful Application of the Proper Law

With the validity of the Clark patent in view of the prior art squarely in issue, the Court of Appeals found it necessary to discuss in detail only the Stow prior art inasmuch as Stow clearly anticipated the Clark patent and established that Clark was not the first inventor of the subject matter set forth in the Clark patent claims.

1. *The Court of Appeals Followed the Recent Supreme Court Decisions*

The Court of Appeals recognized that in determining patentability, they were invoking the Constitutional standard which was designed "with the goal of limiting monopoly to situations of probable public benefit" (App. 20a).

The Court looked to *Graham* v. *John Deere Co.*, 383 U.S. 1 (1966), and found that "[t]he three germinal tests of patent validity are utility, novelty, and nonobviousness" (App. 21a).

Specifically, with respect to the novelty requirement, the Court of Appeals noted (App. 21a) that 35 U.S.C. § 102 (1964)

> requires that the patentee be the original inventor of the object claimed in his patent, and also that the invention not have been known by others before his discovery of it. Thus, one obviously cannot be the original inventor if someone else has described or used the subject matter of the claims before the earliest moment to which he can trace his invention.

Responding to the statute, the Court of Appeals studied the entire Clark patent including the specification, claims and prosecution history and concluded (App. 19a):

> The patent is anticipated by the prior art. As written, its claims include only the invention of Stow with no novel additions. . . .

In disposing of Petitioners' arguments as to the alleged merit of the Clark device and its alleged importance in the medical field, the Court of Appeals followed *Anderson's-Black Rock, Inc.* v. *Pavement Salvage Co.*, 90 S.Ct. 305, 308 (1969), wherein this Court recently reaffirmed that

> Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain . . . .

The Court below properly concluded that "a patent claiming a device that has already been put to use, albeit in a different manner, is invalid" (App. 22a), and that the Clark patent removed from the public domain the Stow device which had been previously dedicated to the public.

2. *The Court of Appeals Decision Is Not in Conflict With United States v. Adams or Any Other Case Cited by Petitioners*

The Court of Appeals specifically rejected the proposition that the facts of this case support any legitimate analogy to *United States* v. *Adams*, 383 U.S. 39 (1966) (App. 27a, n.-17):

> [Petitioners] relied heavily upon the *Adams* case in the trial court, claiming that the patent sued upon here presents an "analogous" legal situation. The situations are clearly not analogous . . . .
>
> These [Clark patent] claims, in comparison to those held valid in *Adams*, are extremely general. The situation would be comparable, in light of the prior art, only if in *Adams* the Supreme Court had held valid a patent claiming any and all batteries capable of construction, no matter what their components or mode of operation.

The Petition not only persists in this erroneous analogy but also mischaracterizes the Court of Appeals decision as holding that the Clark device was concededly patentable. The Court of Appeals made no such holding — it merely refused to be decoyed into considering the validity issue without considering the Clark patent and the claims the patent makes.

Indeed, the question of whether Clark might have made a patentable invention has never been an issue in this case. Respondents' evidence established that the Clark *patent* defined no patentable invention. Petitioners have never squarely confronted this issue below, and seek to skirt the issue hereby posing a question which misconstrues and misstates what was said by the Court of Appeals.

The Courts of Appeals decisions cited by Petitioners (Pet. 11) as representing judicial constructions of the *Adams*

case at variance with the present Fifth Circuit opinion are not relevant. In each of those cases, discussion of the *Adams* case related to the issue of obviousness, not anticipation. The Fifth Circuit was not required to reach the *Adams* case in the context of nonobviousness inasmuch as the anticipated Clark patent claims sought to remove prior art from the public domain.

B. The Court Measured Petitioners' Conduct Before the Patent Office Against the Long Established Standard

Contrary to Petitioners' assertion in Question 2, the Court of Appeals *did* find that Petitioners were guilty of fraudulent conduct[6] (App. 30a):

> The district court held that the [Petitioners] were not guilty of "fraud" in this case. We find either that the district court was applying the wrong legal standard by construing fraud to mean something less than the "uncompromising duty" of disclosure required by the cases or, alternatively, that the finding is clearly erroneous under the evidence as a whole. We are left with the "definite and firm conviction" that [Petitioners'] conduct did not measure up to the legal standard.

The Court of Appeals correctly recognized that under the circumstances of this case, Petitioners' failure to disclose prior art and their misleading representations to the Patent Office constitute a species of fraud on the Patent Office, and that the legal sanction for such fraud is, of course, invalidity of the patent. See *Walker Process Equipment, Inc.*

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[6] What the Court of Appeals declined to decide is whether Petitioners' fraudulent conduct was of such a "knowing" and "willful" nature as to constitute intentional fraud which would support an antitrust claim under *Walker Process Equipment Co.* v. *Ford Machinery & Chemical Co.*, 382 U.S. 172 (1965). On this issue, the Court of Appeals remanded for further proceedings.

v. *Food Machinery & Chemical Corp.*, 328 U.S. 172, 176, (1965); *Strong* v. *General Electric Co.*, 305 F. Supp. 1084, 1086 (N.D. Ga. 1969); *Monsanto Co.* v. *Rohm & Haas Co.*, 312 F. Supp. 778, 791-94 (E.D. Pa. 1970).

In evaluating Petitioners' conduct, the Court of Appeals had reference to the well established standard, affirmed in *Walker, supra*, and originally set forth in *Precision Instrument Mfg. Co.* v. *Automotive Maintenance Machinery Co.*, 324 U.S. 806, 818 (1945):

> Those who have applications pending with the Patent Office or who are parties to Patent Office proceedings have an uncompromising duty to report to it all facts concerning possible fraud or inequitableness underlying the applications in issue. [Citation omitted.] This duty is not excused by reasonable doubts as to the sufficiency of the proof of the inequitable conduct nor by resort to independent legal advice. Public interest demands that all facts relevant to such matters be submitted formally or informally to the Patent Office, which can then pass upon the sufficiency of the evidence.

The *Precision* standard clearly has reference to the broad spectrum of activities of an applicant before the Patent Office, and is not limited, as the Petition suggests, to a proscription against merely use of perjured testimony as in *Precision, supra*, or failure to disclose a prior public use as in *Walker, supra*.

The basis of the patent system is that the original inventor is entitled to the exclusive patent right but that he shall be so entitled, as a fundamental condition, only when the discovery is novel over the prior art.

Petitioners withheld from the Patent Office prior art evidence which not only negatived the novelty of Clark's claimed invention, but also established that *Clark was not the first inventor of the subject matter claimed.*

Petitioners' suggestion that the "uncompromising duty" of the *Precision* case does not apply to disclosure by applicants of facts in these two most critical areas of inquiry, would virtually nullify the *Precision* and *Walker* requirements of candid disclosures by applicants.

Further, the patent statute itself, 35 U.S.C. § 115 (1964), requires that an applicant execute an oath that he believes that he is the original and first inventor of the subject matter for which he solicits a patent.

The truth of that oath is the premise upon which the Patent Office conducts its entire examination of a patent application. To permit a false oath to be made, or to permit one to secrete knowledge which establishes the falsity of the oath, is to totally undermine the *Precision* and *Walker* cases.

1. *The Circuits Are In Agreement That An Applicants' Concealment of Anticipatory Prior Art Can Constitute Fraud On the Patent Office*

Petitioners here attempt to manufacture a conflict between circuits in judicial determination of the standard of conduct to be observed by patent applicants. Even though these various courts have used different language as applied to their individual facts, all the cases cited by Petitioners unanimously agree that a duty to cite anticipatory prior art invariably exists. In those cases the duty was not breached.

For example, *United States* v. *Standard Electric Time Co.*, 155 F.Supp. 949, 952 (D. Mass. 1957), *app. dismissed* 254 F.2d 958 (1st Cir. 1958), did *not* hold, as Petitioners suggest, that the obligation to cite prior art accrues "if 'every reasonable man' would say the invention claimed had been anticipated by a publication known to the inventor" (Pet. 12). What Judge Wyzanski *did* say was:

> Of course, a putative inventor must disclose any printed publication which he either knows or believes describes

> the very invention *claimed* . . . . More than this, if he knows of a printed publication which plainly describes his claimed invention, or comes so close thereto that every reasonable man would say the invention *claimed* was not original but had been anticipated, then regardless of his personal view that he is the first inventor he will not be excused for his failure to disclose such knowledge. [Emphasis added.]

The Court of Appeals specifically rejected the assertion that Petitioners considered the Stow prior art irrelevant (App. 32a):

> This assertion, however, is rendered *utterly incredible* by both Beckman's conduct and by the obvious similarity of the Stow and Clark devices. [Emphasis added.]

The Court of Appeals could not have chosen stronger words to reject the Petitioners' feeble efforts at justification. Despite the afterthought arguments of counsel, the record is totally devoid of any exculpatory evidence of any good faith, inadvertence, or honest mistake on the part of Petitioners.

Petitioners suggest that the opinion of the Court of Appeals is "at variance with all other courts that have considered the matter, [and] it announces a rule of 'uncompromising duty' to 'reveal prior art'" (Pet. 13-14). No such rules respecting *all* prior art was announced. Surely, any standard of conduct, whether evolved from *Precision*, *supra*, or born from a recognition of the implicit need for candor before the Patent Office, would condemn Petitioners' behavior.

2. *The Court of Appeals Opinion Imposes No New Rule of Conduct for Patent Applicants*

Petitioners' forecast of the "devastating effect" of the Court of Appeals decision on the patent system is so palpably synthetic as not to require extensive comment.

Nowhere does the Court of Appeals opinion propound a rule that applicant must cite all known prior art to the Patent Office, or that applicants must conduct a prior art search. If indeed the Court of Appeals opinion threatens previously issued patents, its effect would be felt only by those applicants who have deliberately procured patents invalid over known prior art to use them as tools of business aggression.

C. The Validity Question Here Has None of the Aspects to Which This Court Has Looked in Granting Certiorari in a Patent Case

Ordinarily, a petition for writ of certiorari is not granted to review the issue of invalidity of a patent, based on questions of anticipation or obviousness in the absence of a conflict between the Courts of Appeals as to the validity of the patent. *General Talking Pictures Corp.* v. *Western Electric Co.*, 304 U.S. 175, 178-79 (1938); *Layne & Bowler Corp* v. *Western Well Works*, 261 U.S. 387, 392-93 (1923); *Keller* v. *Adams-Campbell Co.*, 264 U.S. 314, 319-20 (1924). There is no conflict between Courts of Appeals with respect to the invalidity of the Clark patent.

An exception to this rule exists when the patent dominates a substantial portion of an industry which is so concentrated in one judicial circuit that litigation in other circuits, resulting in a conflict of decisions, is unlikely. *Muncie Gear Works, Inc.* v. *Outboard, Marine & Manufacturing Co.*, 315 U.S. 759, 765-66 (1942); *Schriber-Schroth Co.* v. *Cleveland Trust Co.*, 305 U.S. 47, 50 (1938); accord, *Mackay Radio & Telegraph Co.* v. *Radio Corp. of America*, 306 U.S. 86, 89 (1939). Such a concentration does not exist here.

CONCLUSION

The Petition raises no new legal issue of general importance in the administration of the patent laws, and there is no conflict in decisions.

It is therefore respectfully submitted that the Petition for Writ of Certiorari should be denied.

Respectfully submitted,

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October 22, 1970

CONFIDENTIAL

December 6, 1956

T. V. Parke

Allen Strickler

Patent Application on Clark Oxygen Electrode

cc: J. F. Bishop
W. I. Kaye
J. E. Leonard

As per our recent conversation, and to help assure the best possible prosecution of the Clark oxygen electrode patent application, I am arranging for transfer of this case to Harris, Kiech, Foster and Harris.

A related matter has now come up that creates a rather ticklish situation. As of early 1954, Dr. Richard W. Stow of the Ohio State University Medical Center corresponded with our Sales Department and pH meter group concerning a glass electrode adaptation that he was developing for pCO_2 measurement. Its most immediate and perhaps most important application is the measurement of CO_2 pressure in blood. His work was at least in part financed by the National Infantile Paralysis Foundation. The electrode is similar to the Clark design in that the reference and measuring electrode are both placed behind a single semi-permeable membrane. The Stow device clearly is within the scope of claims now in the Clark application. It happens further that Clark and Stow have known about each other's work, and from time to time have discussed these matters together. Toward the end of 1954, when we were preparing to send specimen electrodes to Dr. Stow and awaited further information from him, he dropped further contact with us. Within the last month or two he has again taken this matter up and written to us. On

October 1st he received from us a combination glass electrode which he adapted to his purposes and reported in his letter to John Leonard of November 21st.

By oversight, the Stow development was not brought to my attention when I was given the Clark matter to study. I had myself seen some of the Stow correspondence in 1954, but it slipped my mind completely.

We do not at the present time know whether Clark or Stow is the prior inventor as concerns the broad claims of the Claim application. The Stow invention applied to pCO_2 measurement may independently be of substantial interest and importance to Beckman. If so, a deal may be in prospect with Stow. If indeed Stow has the priority on the broad concept of a dual electrode with a permeable membrane, there is strong additional incentive to have some agreement with him. If his development is commercially important, and Beckman negotiates for patent rights, we may be interested in protecting foreign patent rights as well. If this is a possibility I recommend we very promptly write Stow and advise that it will be to his advantage, and perhaps to Beckman also, if he will withhold publication for the time being. This will protect the patent rights in Great Britain, as one important example, where rights would be voided unless at least the U. S. application is filed first.

We should get together and discuss this matter within the next two or three days. Perhaps a conference is in order, attended by at least you, Wilbur Kay, John Leonard and myself.

Allen Strickler

AS:bs